UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,590	02/08/2002	Dale F. McIntyre	83782F-P	2698

7590 08/13/2007

Milton S. Sales
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER	
HARPER, LEON JONATHAN	
ART UNIT	**PAPER NUMBER**
2166	

MAIL DATE	DELIVERY MODE
08/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/071,590	MCINTYRE ET AL.	
	Examiner	Art Unit	
	Leon J. Harper	2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 February 2007*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11 and 14-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11, 14-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/071,590
Filing Date: February 08, 2002
Appellant(s): MCINTYRE ET AL.

Frank Pincelli
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/7/2006 appealing from the Office action mailed 11/09/2005.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5983229	Houchin et al.	11-1999
5025396	Parks et al.	6-1991

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-11, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houchin et al. ('Houchin' hereinafter), USP 5,983,229 in view of Parks et al. ('Parks' hereinafter), USP 5,025,396.

With respect to claim 1,

Houchin discloses a method for automatically updating non-image data stored at a first storage location using a first image application, said non-image data being associated with a digital image of a user (see col. 2, lines 18-26), comprising the steps of:

providing new information with respect to said digital image in a second image application same (see col. 1, lines 5-11); and

automatically updating said non-image data at said first storage location with respect to said information (see col. 2, lines 54-56, Fig. 1).

Houchin does not explicitly indicate claimed "automatically updating".

Parks discloses automatically updating (automatically update the coded data, see col. 10, lines 3-6, Parks).

It would have been obvious to one ordinary skill in the data processing at the time of the present invention to combine teachings of the cited references because automatically updating of Parks teaching would have allowed Houchin's system to merge of digitalized images with alphanumeric character strings in a data processing as suggested by Parts at col. 1, lines 12-13.

As to claim 2,

Houchin teaches wherein said second image application further comprises an application for the production of an image product (see col. 2, lines 18-26).

As to claim 3,

Houchin teaches wherein said second image application runs on a computer which is associated with said first storage location (see col. 3, lines 36-39, Fig. 2 et seq).

As to claim 4,

Houchin teaches wherein said non-image data and said digital image are stored at said first storage location (see col. 3, lines 66-66, Fig. 3 et seq).

As to claim 5,

Houchin teaches wherein said non-image data is contained within said digital image (see col. 3, lines 66-66, Fig. 3 et seq).

As to claim 6,

Houchin teaches wherein said provided information is used to update said non-image data associated with a group of said digital images of a user (see col. 4, lines 10-15, Fig. 3 et seq).

As to claim 7,

Houchin teaches wherein said group of said digital images comprises an album page and said provided non-image information is provided with respect to a feature of the album page (see col. 3, lines 66-66, Fig. 3 et seq).

With respect to claim 8,

Houchin discloses a method for automatically updating non-image data stored at a first location, said information being associated with a digital image of a user (see col. 2, lines 18-26), comprising steps of:

providing at least one digital image of a user to a remote image server (see col. 1, lines 5-11);

said user granting access to at least one third party to said at least one digital image stored at said remote image server (see col. 1, lines 5-11 and Abstract);

said third party providing information with respect to said at least one digital image using an image application running at said remote site (see col. 1, lines 5-11); and

automatically updating said non-image data with said information (see col. 2, lines 54-56, Fig. 1).

Houchin does not explicitly indicate claimed "automatically updating".

Parks discloses automatically updating (automatically update the coded data, see col. 10, lines 3-6, Parks).

It would have been obvious to one ordinary skill in the data processing at the time of the present invention to combine teachings of the cited references because automatically updating of Parks teaching would have allowed Houchin's system to merge of digitalized images with alphanumeric character strings in a data processing as suggested by Parts at col. 1, lines 12-13.

As to claim 9,

Houchin teaches wherein the step of said third party providing information with respect to said at least one said digital image further comprises providing comments with respect to a photo album stored at said remote site (see col. 3, lines 66-66, Fig. 3 et seq).

With respect to claim 10,

Houchin discloses a method for updating non-image data stored at a first location, said information being associated with a digital image of a user (see col. 2, lines 18-26), comprising steps of:

providing at least one digital image of a user to a remote image server (see col. 1, lines 50-51 et seq);

said user granting access to at least one third party to said at least one digital image stored at said remote image server (see col. 2, lines 63-67 et seq);

said third party providing information with respect to said at least one digital image in an image application running at said remote image server (see col. 3, lines 66-66 and Abstract, Fig. 3 et seq);

notifying said user of the existence of said information with respect to said at least one digital image (see col. 3, lines 66-66, Fig. 3 et seq); and

automatically updating said non-image data with said information if said user decides to do so (see col. 4, lines 10-15, Fig. 3 et seq).

Houchin does not explicitly indicate claimed "automatically updating".

Parks discloses automatically updating (automatically update the coded data, see col. 10, lines 3-6, Parks).

It would have been obvious to one ordinary skill in the data processing at the time of the present invention to combine teachings of the cited references because automatically updating of Parks teaching would have allowed Houchin's system to

merge of digitalized images with alphanumeric character strings in a data processing as suggested by Parts at col. 1, lines 12-13.

With respect to claim 11,

Houchin discloses a method for updating non-image data associated with digital images of a user stored at a first storage location (see col. 2, lines 18-26), comprising the steps of:

granting access to said digital images stored at said first location to at least one third party (see col. 2, lines 63-67, Fig. 3 et seq);

transferring at least one of said digital images from said first storage location to said third party's computer over a communication network (see col. 1, lines 50-51 et seq);

said third party providing information with respect to said at least one digital image in an image application running on said third party's computer (see col. 1, lines 50-51 et seq);

notifying said user over said communication network of the existence of said information with respect to said at least one digital image (see col. 3, lines 66-66, Fig. 3 et seq); and

updating said non-image data stored at said first storage location with said information if said user decides to do so (see col. 4, lines 10-15, Fig. 3 et seq).

Houchin does not explicitly indicate claimed "automatically updating".

Parks discloses automatically updating (automatically update the coded data, see col. 10, lines 3-6, Parks).

It would have been obvious to one ordinary skill in the data processing at the time of the present invention to combine teachings of the cited references because automatically updating of Parks teaching would have allowed Houchin's system to merge of digitalized images with alphanumeric character strings in a data processing as suggested by Parts at col. 1, lines 12-13.

As to claim 14,

Houchin teaches wherein said computer is located remote from said first storage location (see col. 4, lines 10-15, Fig. 3 et seq).

As to claim 15, Houchin teaches wherein said first storage location comprises a computer of said user and said remote computer comprises that of a third party (see col. 4, lines 10-15, Fig. 3 et seq).

Claim 16 has same subject matter as of claims 8 and 10 and essentially rejected for the same reasons as discussed above.

(10) Response to Argument

This Examiner's answer will address the arguments in the order in which they appear in the appeal brief. For simplicity, Examiner's answer will also label the argument with the claims for which each argument has been advanced

Argument (1) (Claims 8,9,10,11,16): Neither Houchin nor Parks disclose said user granting access to at least one third party to said at least one digital image stored at said remote image server as recited in independent claims 8 and 16 because Houchin merely discloses the ability to manage extension data and Park fails to cure the deficiencies of Houchin.

In response to argument (1): examiner respectfully makes reference is made to MPEP 2144.01 - Implicit Disclosure"[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." In re Preda, 401 F.2d 825, 826,159 USPQ 342, 344 (CCPA 1968). In this case Houchin discloses that applications can manage image data as well as non-image data across network (See column 1 lines 45-51). Therefore while Houchin does use extensions in the management of both image and non-image, an artisan of ordinary skill in the pertinent art would understand that this also includes image data being accessed or copied by a third party since the purpose of allowing applications to run on a network is to grant access to files and resources not stored locally.

Argument(2) (Claims 1-11,14-15):Houchin and Park do not disclose expressly or inherently, at least said third party providing new non-image information with respect to said at least one digital image using a second non-related image software application running at said remote site as rejected in independent claims 8 and 16.

In response to argument (2) examiner respectfully submits that in particular, Houchin teaches this limitation as, providing an image file structure to supports a header, image data, non-image data and extension portions and said extensions portions including extension data and an extension persistence value selected to

indicate if extension data is to be maintained "provide" as part of the image file when modifications "added" have been made to the image data portions of the image file (see col. 2, lines 1-8, Houchin). Further, an application must take to add extension data to the hypothetical image file. The application starts at 30 and steps to reading the number of extensions field 16 from the image file 10 at step 32 and increments this value at step 34. If per decision block 36 the incremented value is 1, the extension about to be added is the first extension to be added to the image file 10. The application must determine the location in the file where the extension data will be written per step 38 and then write the incremented number of extensions, the extension #1 offset and the extension #1 data to the file per step 40. If the incremented value of the number of extensions field is not one, then there are already extensions in this file. The application can read the extension data 26 for the extensions already in the file into a buffer in memory per step 42. The application can then determine the new offsets for both the existing extensions and the new extensions, taking into account the space required to store the extension offset for the new extension per step 44. The new extension data is then added to the buffer in memory per step 46. Finally, the incremented value of the number of extensions field, the buffer of extension data and the extensions offsets are written to the file per step 48 (see col. 3, lines 36-58, Houchin). Moreover, the application is disclosed as running on a remote site for the same reasons as disclosed in argument 1.

Argument (3) (Claims 10,11): Houchin and Parks do not disclose expressly or inherently, at least notifying said user of the existence of said new non-image information with respect to said at least one digital image as recited in independent claims 10,11

In response to argument (3) examiner respectfully submits In this case Houchin discloses verifying extension data (See figures 3 and 4). An artisan of ordinary skill in the pertinent art would understand that one way of verifying information is to ask the user. Asking the user accomplishes 2 goals (1) users can clear up any errors, if they are the reason the system cannot read data (in this case extension data) and (2) users can verify that the data is in fact not valid. Reference is made to MPEP 2144.01 - Implicit Disclosure "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)

Subsequent to an analysis of the claims it was revealed that a number of limitations recited in the claims belong in the prior art and thus encompassed and/or implicitly disclosed in the reference (s) applied and cited. It is logical for the examiner to focus on the limitations that are "crux of the invention" and not involve a lot of energy and time for the things that are not central to the invention, but peripheral. The examiner is aware of the duties to address each and every element of claims, however, it is also important that a person prosecuting a patent application before the Office or an stakeholders of patent granting process make effort to understand the level of one of

ordinary skill in the (data processing) art or the level one of skilled in the (data processing) art, as encompassed by the applied and cited references. The administrative convenience derived from such a cooperation between the attorneys and examiners benefits the Office as well the patentee.

In view of the above, the examiner contends that all limitations as recited in the claims have been addressed in this Action.

Argument (4) (Claims 1-7 and 14-15): Houchin and Park do not disclose expressly or inherently automatically updating said non-image information stored on said electronic memory device at said first storage location with respect to said new non-image information as recited in independent claim 1.

In response to argument (4) examiner respectfully submits that applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Further, in response to applicant's arguments, the Examiner respectfully submits that in particular, Houchin teaches particular limitation as stated above. Houchin does not explicitly indicate claimed "automatically updating". Parks remedy such kinds such kinds deficiency by teaching automatically update the coded data, see col. 10, lines 3-6, Parks. It would have been obvious to one ordinary skill in the data processing at the time of the present invention to combine teachings of the cited references because

automatically updating of Parks teaching would have allowed Houchin's system to merge of digitalized images with alphanumeric character strings in a data processing as suggested by Parks at col. 1, lines 12-13.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Conclusion

Claims 1-11 and 14-16 are properly rejected under 35 U.S.C. §103(a). Houchin discloses all claim limitation with the exception of automatically updating. Parks however cures the deficiency of Houchin by disclosing automatically updating. Therefore the proper and valid combination of Houschin and Parks disclose all claim limitations as stated. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Leon J. Harper
Patent Examiner
Art Unit 2166

Conferees:
1. Hosain Alam, Supervisory Patent Examiner, Art Unit 2166
2. Mohammad Ali, Supervisory Patent Examiner Art Unit 2169

Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201